



Application 08/419,229
Objection dated May 4, 2004
Reply to Office communication of March 23, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Thrift et al.

Serial No.: **08/419,229**

Filed: **04/10/1995**

For: **Voice Activated HyperMedia Systems Using Grammatical Metadata**

Docket No.: **TI-20205**

Examiner: **Dorvil, Richemond**

Art Unit: **2654**

Confirm. No.: **3703**

OBJECTION TO COMMUNICATION FROM EXAMINER PURPORTING
TO CORRECT AN INCOMPLETE RECORD OF THE APPLICATION – MAILED
AFTER ISSUE FEE PAID

Mail Stop Issue Fee

Commissioner for Patents

Alexandria, VA 22313-1450

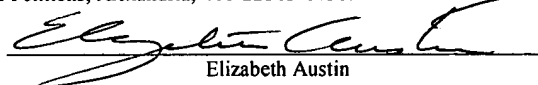
Dear Sir:

EXPRESS MAILING CERTIFICATE

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Date of Deposit: **May 4, 2004**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Mail Stop Petitions, Alexandria, VA 22313-1450.


Elizabeth Austin

Applicants object to the Office Communication mailed on March 23, 2004, as being untimely, inappropriate, erroneous, and a violation of MPEP § 1302.14.

Beginning on page 2, line 3, and ending on page 3, line 4, the Office communication purports to limit the scope of independent claims 11 and 14, 2004. More specifically, the Examiner makes the statement: "With regard to independent claims 11 and 14, the claimed

elements defined by “means-plus-function” format **are construed as being limited to the following corresponding structure or acts described in the specification ...**”. Applicants respectfully submit that the Examiner’s comments beginning on page 2, line 3 and ending on page 3, line 4 of the Office Communication are untimely and inappropriate for the following reasons:

1) THE EXAMINER DID NOT HAVE AUTHORITY TO REOPEN PROSECUTION OR TO ALTER THE GROUNDS FOR ALLOWANCE.

The U.S. Court of Appeals for the Federal Circuit, on August 9, 2002, vacated the Decision of the Board of Patent Appeal regarding the 35 U.S.C. 103 rejection of Claims 11-19. The Court specifically found, “The Board’s decision is not supported by substantial evidence because the cited references do not support each limitation of claim 11” (Appeal No. 01-1445, page 14, lines 3-5). The Court further found, “Appellants urge that there was also insufficient evidence in the record to support the examiner’s and Board’s conclusions regarding obviousness because the cited references do not support all of the limitation of claim 14. We agree that the Board’s decision is not supported by substantial evidence” (Appeal No. 01-1445, page 15, lines 11-15).

MPEP § 1216.01 (D) states the following:

In rare situations it may be necessary to reopen prosecution of an application after a decision by the Federal Circuit. **Any Office action proposing to reopen prosecution after a decision by the Federal Circuit must be forwarded to the Office of the Assistant Commissioner for Patents for written approval, which will be indicated on the Office action.**

No written approval from the Assistant Commissioner for Patents was indicated on the Office Action mailed on September 25, 2003 or on the Office communication mailed by the Examiner to Applicants on March 23, 2004. As a result, the Examiner was without authority under MPEP § 1216.01 (D) to restrict the scope of Claims 11 and 14 in the Office communication mailed by the Examiner to Applicants on March 23, 2004.

2) IT IS INAPPROPRIATE FOR THE EXAMINER TO SUO SPONTE ALTER THE PROSECUTION RECORD AFTER PROSECUTION ON THE MERITS HAS CLOSED:

A Notice of Allowance and Fee(s) Due was mailed by the USPTO on December 30, 2003. Accordingly, prosecution on the merits of this application was closed on December 30, 2003. The Notice of Allowance contained no "Reasons for Allowance" purporting to narrow the scope of the claims.

Applicants paid the Issue Fee on the above Notice of Allowance on March 1, 2004 (Issue Fee payment recorded in the USPTO on March 1, 2004).

The Examiner subsequently mailed the above-identified Office communication on March 23, 2004 – more than three weeks after Applicants paid the issue fee AND almost three months after prosecution on the merits of this application was closed. Accordingly, the language contained on page 2, line 3 – page 3, line 4 of the Office communication mailed March 23, 2004 is untimely and inappropriate.

3) **THE EXAMINER DOES NOT HAVE AUTHORITY FROM THE BOARD OF APPEALS TO RESTRICT THE SCOPE OF CLAIMS 11 AND 14, AS SUGGESTED IN THE OFFICE COMMUNICATION :**

The Examiner justifies limiting the scope of Claims 11 and 14 in the Office communication, as follows:

After a final review of the record of the application prior to issue, **it was determined that the record was incomplete vis-à-vis the board of Patent Appeals and Interference's directive to determine the scope of the means-plus-function language cited in the remand and to provide an analysis as to the patentability of the thus-construed claims in light of the prior art.** See Paper number 24, "REMAND TO THE EXAMINER," paragraph bridging pages three and four, citing In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(en banc). (Office Communication, page 2, lines 6-8)(emphasis added).

Applicants respectfully point out that in its REMAND TO THE EXAMINER, mailed on January 17, 2003, the Board made the following determination:

The above-identified application is hereby remanded to the Examiner for appropriate action **consistent with the decision of the CAFC and our comments below.**

Should the Examiner, after further consideration, decide that it is appropriate to reopen prosecution we make the following observations.

As stated in the CAFC decision of August 9, 2002, the court noted that independent claims 11 and 14 differ from independent claim 1, the obviousness rejection of which was upheld by the court, by adding a grammar creation capability to the claimed voice activated Hypermedia system. The court's decision concluded that the Board erred in affirming the obviousness rejection of independent claims 11 and 14 since the Examiner's assertion that ". . .[t]he use of grammar is old and well known in the art of speech recognition ..." was unsupported by any evidence. Accordingly, **in any future formulation of AN OBVIOUSNESS rejection of independent claims 11 and 14,** the Examiner is required, as a starting point, to provide clear evidence of the existence in the prior

art of grammar creation capability in speech recognition systems. (Remand to the Examiner, page 2, lines 2-22).

Applicants respectfully point out that there is nothing in the decision of the CAFC that suggests that the PTO should restrict Claims 11 and 14 in any manner, let alone the manner attempted by the Examiner in the above-identified Office communication. Moreover, the Board did not direct the Examiner to re-open prosecution – the Board left it up to the discretion of the Examiner. In the event the Examiner CHOSE to reopen prosecution the Board required that the Examiner's action be consistent with both the decision of the CAFC and the comments provided by the Board in its Remand to the Examiner. The Board's comments applied to any obviousness rejection should the Examiner decide to re-open prosecution.

In the Office Action mailed on September 25, 2003, the Examiner **dropped the rejection of the Claims 11-19 under 35 U.S.C. 103(a) and substituted therefore new rejections under 35 U.S.C. § 112, first & second paragraphs**. Group Director Powell subsequently refuted the newly cited 35 U.S.C. §112, first & second paragraph, rejections in an Interview Summary dated December 12, 2003. With no remaining rejections, the application was allowed and Applicants paid the Issue Fee.

Applicants respectfully submit that once Examiner Chawan re-opened prosecution in the Office Action of September 25, 2003 and withdrew all the art rejection(s), the Examiner gave up any right (to the extent there ever was any) from the Board of Appeals, to rely upon authority from the Board in the Remand from the Board to justify restricting the scope of Claims 11 and 14.

4) THE EXAMINER'S ACTION OF RESTRICTING THE SCOPE OF CLAIMS 11 AND 14 IN THE OFFICE COMMUNICATION VIOLATES MPEP § 1302.14.

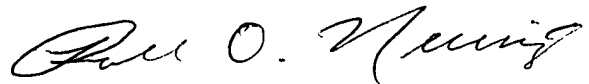
While not explicitly identified as "Reasons for Allowance", the Examiner has attempted to restrict the scope of Claims 11 and 14 through his determination in the Office communication (page 2, line 2 – page 3, line 4). MPEP § 1302.14 specifically states:

Where specific reasons are recorded by the Examiner, care must be taken to ensure that such reasons are **accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims.**

In light of the entire discussion above, it should be clear that the Examiner did not have authority from the Assistant Commissioner for Patents or the Board of Appeals to submit into the record restrictions to the scope of Claims 11 and 14, as set forth in the Office communication. Accordingly, the reasons provided by the Examiner in the Office communication violate MPEP 1302.14 because they were made without authority, are not accurate, not precise and they place unwarranted interpretations upon the claims.

In view of the above traversal of the Examiner's comments in the Office communication of March 23, 2004, Applicants respectfully request the PTO to withdraw and/or refute page 2, line 3 – page 3, line 4 of the Office communication of March 23, 2004.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Ron O. Neerings".

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